REMARKS

The present application was filed on December 7, 2000 with claims 1-20. In the outstanding Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,446,136 to Pohlmann et al. (hereinafter "Pohlmann") in view of U.S. Patent No. 6,584,186 to Aravamudan et al. (hereinafter "Aravamudan").

In this response, Applicants traverse the §103(a) rejection of claims 1-20 based on at least the following reasons.

With regard to the rejection of claims 1-34 under 35 U.S.C. §103(a) as being unpatentable over Pohlmann in view of Aravamudan, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth therein, M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that no motivation or suggestion exists to combine Pohlmann and Aravamudan in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id at 1343-1344.

In the final Office Action, on pages 3-4, the Examiner provides the following statement to prove motivation to combine Pohlmann and Aravamudan, with emphasis supplied:

> "It would have been obvious . . . to combine the teachings of Pohlmann and Aravamudan to have one or more corresponding ac tions to the one or more automatically learn predicates to form the one or more correlation rules because it would have allowed providers to perform automatic dynamic market testing and automatically adjusted served content based on responses from users."

Applicants submit that the statement above is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Pohlmann and Aravamudan in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner's conclusory statements do not adequately address the issue of motivation to combine references. "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

In response to previously submitted arguments, the Examiner simply restates the conclusory statement above regarding what the combination would have allowed providers to perform. Thus, the Examiner fails to meet the standard for establishing obviousness which the Examiner claims to recognize. The Examiner fails to establish an apparent reason to combine the known elements of Pohlmann and Aravamudan, and fails to expressly articulate the underlying analysis supporting a

proffered "apparent reason." The Examiner fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The Examiner also fails to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. The Examiner fails to make this rationale explicit and fails to include a detailed explanation of the effects of demands known in the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art.

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Pohlmann and Aravamudan. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that Pohlmann and Aravamudan are combinable since it is not clear how one would combine them. The combination of Pohlmann and Aravamudan is not a predictable use of prior art elements according to their established functions. Again, no guidance was provided in the Office Action as to how the references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Pohlmann and Aravamudan fails to suggest or render obvious at least the elements of independent claims 1, 8 and 14 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1 recites a computer-based method of constructing one or more correlation rules for use by an event management system for managing a network with one or more computing devices. One or more event patterns representing event data associated with the network of computing devices being managed by the event management system are selected. Predicates of the one or more correlation rules from the one or more selected event patterns are automatically learned. One or more corresponding actions to the one or more automatically learned predicates are added to form the one or more correlation rules. Independent claims 8 and 14 recite additional embodiments of the present invention having similar limitations.

Pohlmann discloses an event management system in which an event manager provides and receives events, an event correlator correlates at least one of the events based on alarm rules, and a

response engine executes a response policy based on the correlation of events by the event correlator. Aravamudan discloses methods and apparatus for protecting against network damage in next generation communication networks.

The combination of Pohlmann and Aravamudan fails to disclose the element of automatically learning predicates of the correlation rules from selected event patterns. The Examiner contends that this is provided in Pohlmann, however, the portions of Pohlmann cited by the Examiner disclose the querying of events and the forwarding or publishing of events matching a subscription request to the requestor. Pohlmann fails to disclose anything regarding predicates of correlation rules, or the automatic learning of such predicates from selected event patterns.

In response to previous arguments, the Examiner contends that this limitation is provided in Aravamudan, however Aravamudan fails to remedy the deficiencies described above with regard to Pohlmann. More specifically, the portion of Aravamudan referred to by the Examiner discloses the correlation of two events in order to issue new policies to reprogram network elements. Aravamudan fails to specifically disclose that predicates of correlation rules are automatically learned from selected event patterns. Aravamudan fails to "clearly show predicates of the correlation rules for selected event patterns," as the Examiner contends. Further, it is improper for the Examiner to conclude that "since Aravamudan does not mention or indicate about manually learning predicate, therefore, it is automatically learning," without providing evidence that supports such a conclusion. Therefore, the combination of Pohlmann and Aravamudan fails to disclose this element of the independent claims.

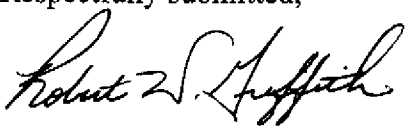
The combination of Pohlmann and Aravamudan also fails to disclose the element of adding corresponding actions to the automatically learned predicates to form correlation rules. The Examiner contends that this element is provided in Aravamudan, however, the portion of Aravamudan again cited by the Examiner discloses the correlation of two events in order to issue new policies to reprogram network elements. Aravamudan fails to disclose anything regarding the addition of corresponding actions to automatically learned predicates to form correlation rules. Pohlmann fails to remedy the deficiencies described above with regard to Aravamudan . Therefore,

the combination of Pohlmann and Aravamudan fails to disclose this element of the independent claims.

Dependent claims 2-7, 9-13 and 15-20 are patentable at least by virtue of their respective dependency from independent claims 1, 8 and 14, and also recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-20 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejection.

Respectfully submitted,



Date: June 28, 2007

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